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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,097	06/15/2001	Valerie De La Poterie	05725.0905-00	7312

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EXAMINER

LAMM, MARINA

ART UNIT PAPER NUMBER

1616

DATE MAILED: 08/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/881,097

Applicant(s)

DE LA POTERIE ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-56 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

Claims 1-59 are pending in this application filed 6/15/01.

#### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Election/Restrictions*

2. Applicant's election with traverse of Group I, Claims 1-56 and 59 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that examination of both groups together would not constitute a serious burden. This is not found persuasive because the search required for Group I is not required for Group II.

The requirement is still deemed proper and is therefore made FINAL.

3. Applicant's election of species (a) polyurethane film-forming polymers and (b) polycaprolactones thermal transition agents is acknowledged. Claims readable on elected species are 1-10, 15-19, 21-56 and 59.

#### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of copending Application No. 09/880,792 and claims 1-39 of copending Application No. 09/880,787. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present subject matter overlaps with that previously claimed. Thus, the conflicting claims are directed to compositions for a keratinous material comprising at least one film-forming polymer and at least one thermal transition agent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Claim Objections*

6. Claim 44 is objected to because of the following informalities: the use of bullets. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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8. Claims 1-18, 20-31 and 46-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodelin et al. (US 6,264,933).

Bodelin et al. teach compositions for coating keratin fibers (e.g. mascara compositions) containing 0.05-10% of at least one film-forming polymer which is dispersed in the aqueous phase in the form of solid particles having the size from 10 nm to 500 nm. See Abstract; col. 4, lines 5-8, 14-16. The compositions may also contain from 0.01 to 5% of an additional water-soluble film-forming polymer. See col. 4, lines 30-63. The film-forming polymers of Bodelin et al. include polyurethanes, vinyl copolymers, acrylic polymers and copolymers, polymers of natural origin, etc. See col. 2, lines 34-55. The polymer system may comprise at least one film-forming auxiliary agent for obtaining the desired film. See col. 3, lines 31-65. The liquid fatty phase of the compositions contains 35-75% of at least one volatile organic solvent and may contain 0-5% of non-volatile oils. See col. 5, lines 38-67; col. 6-7. The compositions of Bodelin et al. can also contain at least one soft wax having a melting point of 45-70° C, e.g. polyethylene waxes. See col. 7, lines 54-67. Polyethylene waxes having a melting point of 45-70° C will inherently act as thermal transition agents. The compositions of Bodelin et al. may also contain cosmetic compounds such as vitamins, pigments, fragrances and emulsifiers. See col. 9; Examples.

With respect to the recited film resistance to hot and cold water, these limitations are inherent in the reference because the reference teaches the same film-forming and thermal transition agents employed as the same amounts as claimed in the instant claims.

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Thus, Bodelin et al. teach, either expressly or impliedly, each and every limitation of Claims 1-18, 20-31 and 46-56.

***Claim Rejections - 35 USC § 103***

9. Claims 32-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodelin et al. in view of Simon (US 6,333,053) and Mougin et al. (US 5,851,517).

Bodelin et al. applied as above.

While teaching aqueous dispersion of film-forming polymer particles, Bodelin et al. do not teach non-aqueous dispersion of surface-stabilized polymer particles as claimed in the instant claims.

However, Simon teaches aqueous and non-aqueous dispersions of polymer particles used as film-formers in cosmetic compositions. See col. 6, lines 7-19; col. 10, Claim 47. The polymer particles dispersed of in a non-aqueous medium are surface-stabilized by sequential or grafted block copolymers. See Mougin et al. col. 1-5.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use non-aqueous dispersions of polymer particles of Simon and Mougin et al. for compositions of Bodelin et al. with a reasonable expectation of deriving the same cosmetic effect as set forth in the Bodelin et al. reference.

10. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bodelin et al.

Bodelin et al. applied as above.

While teaching dimethicone copolyols, the reference does not explicitly teach the claimed concentration. See col. 9, line 28. However, it would be conventional and within the

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skill of the art to identify the optimal concentration of the emulsifier in order to achieve the desired cosmetic effect and/or stability of the composition.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

*Conclusion*

11. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.


The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml

8/12/02

  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER